

## **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No.	:	10/815,130	Conf. No.	:	9169
Applicant	:	PARSONEAULT, Norbert	Filed	:	Mar. 31, 2004
Examiner	:	KRAUSE, Justin M.	TC/A.U.	:	3682
Docket No.	:	8209.053.NPUS01			
Title	:	FLUID DYNAMIC BEARING SPINDLE MOTOR			

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### **REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION**

Applicant respectfully requests that the finality of the presently pending Office Action be withdrawn. The final Office Action was issued improperly and its finality is directly contradictory to the rules as set forth in the MPEP. As established therein:

*The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. MPEP § 1207.04.*

The details of this matter are as follows:

On July 25, 2006 a restriction requirement was issued. Applicant responded to the restriction requirement on August 25, 2006 without making any amendments to the claims. Thereafter, a non-final Office Action was issued on October 26, 2006, to which Applicant

responded with an amendment to the claims. On March 29, 2007, a first final Office Action was issued rejecting claims 1, 2, 3, 6, 9-14, 21, and 22 under 35 U.S.C. § 103 (a) as allegedly obvious over Usui (U.S. Patent No. 5,924,798) in view of Nii et al. (U.S. Patent No. 4,938,611, claims 1-3 and 6-8 under 35 U.S.C. § 103 (a) as being unpatentable over Tanaka (U.S. 2001/0022869) in view of Nii, and claims 4 and 5 under 35 U.S.C. § 103 (a) as being unpatentable over Tanaka in view of Nii as applied to claims 1-3, further in view of Titcomb (U.S. Patent 5,516,212). Applicant responded to the final Office Action without making any amendments to the claims.

Thereafter, an Advisory Action was issued stating that Applicant's arguments were not persuasive. Applicant filed a Notice of Appeal and followed by an Appeal Brief. However, Applicant never received an Examiner's Answer. After the Appeal Brief was filed, and to Applicant's surprise, the Examiner reopened prosecution and issued a second final Office Action. The second final Office Action states that there are new grounds of rejection. However, the only difference between the first and second final Office Actions is a change of wording in the old rejections and a new rejection of claims 1-3 under 35 USC § 102(b) as allegedly being anticipated by Nii. Furthermore, the Examiner dismissed Applicant's previous arguments merely stating "Applicant's arguments with respect to claims 1-14, 21 and 22 have been considered but are moot in view of the new ground(s) of rejection."

Applicant respectfully submits that the new grounds of rejection after Appellant's brief was filed was not either necessitated by amendment, or based on information presented in an information disclosure statement. Applicant was not given the proper opportunity to respond to the new grounds of rejection. Instead of continuing with the appeal, the Examiner instead reopened prosecution based on a new ground of rejection that was not initiated by any action by Applicant. By this action the Examiner has prevented Applicant from amending the claims without filing a Request for Continued Examination and paying a substantial fee. Therefore, Applicant is unjustly harmed without recourse.

Since no amendments caused the Examiner to issue the new grounds of rejection, the grounds could not have been necessitated by amendment (as required to make the Office Action final). Therefore, the finality of the second final Office Action was made in error and in direct conflict with the MPEP. Accordingly, applicant respectfully requests that the finality of the present Office Action be withdrawn.

If there are any fees due with the filing of this Request, including any fees for an extension of time, applicant respectfully requests that extension and also requests that any and all fees due be charged to Deposit Account No. 14-1437.

Respectfully submitted,  
NOVAK DRUCE & QUIGG LLP

Date: November 12, 2008

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